

**REMARKS**

Claims 1-4 and 8-11 are amended by deleting the word "general" in the phrase "general formula" as some Examiners consider this phrase to be indefinite.

Claims 2-7 and 9-14 are amended by changing the first word "A" to "The" to correct a minor informality.

Claim 8 is amended to recite a positive image forming material comprising a positive image forming layer on a substrate which includes at least (A) a novolac type phenolic resin containing phenol as a structural unit, (B) a photo-thermal converting agent and (C) an onium salt represented by formula (1-2), wherein the positive image forming material does not include a crosslinking agent. Support is found, for example, in the Summary of the Invention (se, e.g., page 4, lines 6-8) and in the Examples.

Claims 9-14 are further amended by inserting the word "positive" in the preamble of the claim to be consistent with amended claim 8.

Claim 11 is amended to include the definition of  $R^3$  as disclosed on page 18, lines 6-8 after formula (I) in the specification.

New claims 15 and 16 are added herein as dependent upon claim 8. Support for the new claims is found, for example, on page 99 and pages 137 to 138.

Upon entry of the Amendment, claims 1-16 will be all of the claims pending in the application.

**I. PTO/SB/08 Forms**

The Examiner has not yet returned an initialed copy of the PTO/SB/08 forms filed on January 21, 2004, October 25, 2004, and June 8, 2005. Applicants respectfully request the

Examiner return initialed copies of the PTO/SB/08 forms filed on January 21, 2004, October 25, 2004, and June 8, 2005 with the next Action.

**II. Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

Claim 11 is rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as allegedly being indefinite because  $R^3$  is not defined in formula (I).

Claim 11 is amended to include the definition of  $R^3$  as disclosed on page 18, lines 6-8 after formula (I) in the specification, thereby obviating the rejection. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

**III. Claim Rejections – 35 U.S.C. § 102**

Claims 8, 10 and 14 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kobayashi.

Applicants respectfully submit that Kobayashi does not disclose, teach or suggest the presently claimed invention.

Claim 8, as amended, relates to a positive image forming material comprising a positive image forming layer on a substrate which includes at least (A) a novolac type phenolic resin containing phenol as a structural unit, (B) a photo-thermal converting agent and (C) an onium salt represented by formula (1-2), wherein the positive image forming material does not include a crosslinking agent.

On the other hand, Kobayashi is related to a negative image forming material as is clear from the Abstract of Kobayashi. The difference can be considered as a basic difference in

image forming mechanisms. The mechanism of the positive image forming material is described in the "Background" section of the present specification.

The negative image forming material of Kobayashi cannot be used as a positive image forming material. In the negative image forming material of Kobayashi, portions exposed to light cure to form image portions, as described in the last paragraph of the "Summary" section of Kobayashi (i.e., column 2, lines 19-29). In contrast, in the positive image forming material of the present invention, portions exposed to light are dissolved to form non-image portions. Accordingly, the negative image forming material of Kobayashi is totally different from the positive image forming material of the presently claimed invention.

Further, claim 8 is amended herein to recite that a crosslinking agent is not included in the positive image forming material. Contrarily, a crosslinking agent is an essential component of Kobayashi as described in the Abstract of Kobayashi. However, a crosslinking agent is not employed in the presently claimed invention. Therefore, Kobayashi et al does not disclose, teach or suggest the presently claimed invention.

Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102.

#### **IV. New Claims**

New claims 15 and 16 depend from claim 8 and are distinguished over the cited references for at least the same reasons.

#### **V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

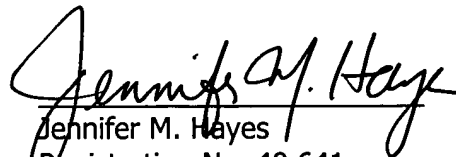
AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 10/760,497

ATTY DKT Q79439

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Jennifer M. Hayes  
Registration No. 40,641

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 28, 2005